

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/971,946 Confirmation No. 4092
Appellant : Jean-Patrick Azpitarte
Filed : October 4, 2001
TC/A.U. : 2152
Examiner : Dohm Chankong

Docket No. : 01-600
Customer No. : 34704

DECLARATION

I, PIERRE GENDRAUD, hereby declare that:

1. I am briefed by Mr Bertrand Warusfel of the firm of Attorneys: Cabinet Feltesse, Warusfel, Pasquier & Associés of 15, Boulevard du Palais, 75004 Paris, France.
2. I have been asked to give an Opinion on the validity and pertinence of Prior Art cited against a US patent application filed by Mr Jean-Patrick Azpitarte who is a client of Cabinet Feltesse, Warusfel, Pasquier & Associés.
3. Mr Azpitarte filed US Patent Application SN 09/971,946 (" '946 patent application") on October 4, 2001. This application was published under number US2002/0059412 on May 16, 2002.
4. US Patent Application SN 09/971,946 claims an earlier priority date of October 4, 2001.
5. The '946 patent application relates to a system for remotely and automatically controlling, by a facilities management company, maintenance of facilities by a maintenance company with regard to a contract binding the maintenance company to the facilities management company.
6. In the course of the prosecution of the '946 patent application, an Office action issued in which objections were raised to the patentability of the invention claimed in the application.



7. Notably, the Examiner raised objections based on a prior art document, namely US Patent Application published under US2003/0172002 in the name of Spira et al. (hereinafter "Spira et al." or "Spira").
8. The Spira document results from a PCT application – WO 01/71607 – designating the USA under number PCT/US01/08328.
9. This PCT application WO 01/71607 claims the priority of an earlier US patent application, namely Provisional Application 60/190,170 filed on March 17, 2000.
10. The filing date of Spira's PCT/US01/08328 is March 15, 2001 which is before the filing date of Mr Azpitarte's patent application, but later than its priority date.
11. In order for the Spira reference to be available prior art, it must be shown to be entitled to its priority date of March 17, 2000.
12. My brief in this matter is to give an Opinion as to whether the cited document in the name of Spira - US2003/0172002 – is indeed entitled to its priority date of March 17, 2000 and can thus be validly cited by the Examiner against Mr Azpitarte's patent application.
13. This Opinion is based on a study of the following documents that have been provided to me:

The Patent Application at issue:

- US Patent Application SN 09/971,946, published under number US2002/0059412 on May 16, 2002, in the name of Mr Jean-Patrick Azpitarte.
- The Office Action issued by Examiner Dohm Chankong dated March 18, 2008.
- The priority document, FR 0012675, whose priority date is claimed in US Patent application 09/971,946, and the certified translation thereof.

The Prior Art cited in the Office Action:

- US Patent Application published under US2003/0172002 in the name of Spira.

The priority document whose date is claimed in the Spira application:

- US Provisional Application 60/190,170 filed on March 17, 2000 of which the priority date is claimed in US2003/0172002.

14. I have drafted this Opinion based on my professional experience in the field of Industrial Property, and in particular, that relating to the prosecution of patent applications in various countries including the USA.

15. My Opinion is based on the information contained in the documents listed above that have been communicated to me, and takes into account my fundamental obligation to remain at all times objective and impartial as is required by my role as legal Expert.

16. I believe that the information given herein to be true and that my Opinion is both fair and true.


17. The Opinion comprises only the present document and is final. However, should any new documents or information be subsequently communicated to me, I may be required to review the present Opinion in their light.

18. My professional qualifications fall into two categories: technical and legal.

19. I have a degree in Engineering from the French Engineering school "Ecole Supérieure de Physique & Chimie Industrielle de Paris (ESPCI)". I also have a Masters degree in Private Law specialising in Legal Careers.

20. I have been employed since 1996 as Industrial Property Director of PSA Peugeot Citroën, a French automobile group. In this function I am head of a team of some forty people, based in the greater Paris area, who draft and prosecute the Group's patent applications and ensure their enforcement and valorisation with respect to third parties.

21. I am personally responsible for defining the Group's industrial property strategy, negotiating major license agreements and dealing with litigation on behalf of the Group.


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22. In addition, since 1993 I have been an accredited Expert in Industrial Property before the French Court of Appeal in Paris. Furthermore, since 2003 I have been an accredited Expert before the French Court de Cassation and became an accredited Expert before the Administrative Courts of Appeal of Paris and Versailles in 2006.

23. In the fifteen years during which I have been practicing as an accredited Expert in Industrial Property, I have been briefed some hundred times by the Courts, or Courts of Appeal in Paris or in other parts of France. These briefs principally involved patent litigation, notably involving the evaluation of damages in matters of patent infringement.

24. Furthermore, I have been briefed as an Expert when seeking amicable settlements in some forty litigations, giving opinions on the relevance of prior art, questions of novelty, the infringement of Industrial Property rights, the damages suffered by a Party to an action as well as other opinions.

25. I am also a member of the Licensing Executives Society (France), more commonly known as LES-France, and more especially I am president of the "Automotive working Group" of Licensing Executives Society International, more commonly known as LESI. I have attended numerous Conferences organised by these associations and have taken part in various working groups, notably the "patent and Technology Licensing" group which dealt with the evaluation of licensing royalties.

26. As regards the subject of the present Brief, I qualified as a European Patent Attorney in 1980. I also qualified as a French patent attorney recognized by the French Patent Office in 1980. In the course of a career in Industrial Property dating from 1975 I have dealt with the prosecution of a large number of patent applications in numerous countries. A high proportion of patent applications filed by my employers have had corresponding applications filed in the USA. Thus, I have considerable experience of the theory and practice of filing, prosecuting and obtaining patents both in Europe and in the USA.

27. My professional training and qualifications, as well as my professional experience mean that I am also familiar with the theory and practice relating to the claiming of priority in patent applications.

28. I am charged with giving my Opinion as to whether the document in the name of Spira - US 2003/0172002 – is entitled to its priority date of March 17, 2000 and thus can be validly cited against Mr Azpitarte's patent application.
29. To this end I shall consider the prosecution history of Mr Azpitarte's US Patent application 09/971,946 and its entitlement to its priority date before proceeding to study the content of US Patent Application published under US 2003/0172002 in the name of Spira and that of US Provisional Application 60/190,170 filed on March 17, 2000 whose priority date is claimed in the later application.
30. A basic French national patent application – FR 0012675 – entitled "Système pour la gestion à distance de la maintenance d'un ensemble d'équipements" was filed by Mr Azpitarte on October 4th, 2000.
31. On October 4th, 2001, Mr Azpitarte filed a corresponding patent application in the USA, entitled "System for remotely managing maintenance of a set of facilities", claiming the priority of his earlier application.
32. This US patent application was given the filing number 09/971,946 and was subsequently published under the number US 2002/0059412.
33. The priority date claimed for this US application was October 4, 2000.
34. Following a Preliminary Amendment, the claims on file in US patent application 09/971,946 are currently Claims 13 and 15-25.
35. The single independent main claim, Claim 13, relates to a system for remotely and automatically controlling, by a facilities management company, maintenance of facilities by a maintenance company with regards to a contract binding the maintenance company to the facilities management company.
36. Following examination of this application, an Office Action issued on February 14, 2006, and again on March 17, 2008, in which objections were raised to the patentability of the claims on file.

37. In particular, the Examiner based his principal objections on a prior art document, US Patent Application published under US2003/0172002 in the name of Spira. The Examiner alleged that it would have been obvious to one of ordinary skill in the art to adapt the system disclosed by Spira and so arrive at the invention claimed by Mr Azpitarte in the principal claims of his application.
38. The Examiner also raised further objections to the sub claims, based on the Spira citation taken in combination with other references.
39. However, US 2003/0172002 in the name of Spira was filed on March 15, 2001. This date is earlier than the filing date of US Patent Application 09/971,946, namely October 4, 2001, but after the priority date thereof, namely October 4, 2000.
40. In order for this reference to be validly cited by the Examiner against the Claims of US Patent Application 09/971,946 in the name of Mr Azpitarte, the reference must be shown to benefit from its priority date of March 17, 2000 which is earlier than the priority date of US Patent Application 09/971,946.
41. Before considering the question of whether the prior art reference can be validly cited against the application in the name of Mr Azpitarte, it is first necessary to establish what is the earliest date of Mr Azpitarte's application.
42. US patent application 09/971,946 in the name of Mr Azpitarte was filed on October 4, 2001.
43. The priority date claimed for this US application was October 4, 2000, being the date of filing of the basic French application FR 0012675.
44. US Patent Application 09/971,946, published under no. US 2002/0059412 has a description comprising 85 numbered paragraphs followed by 12 claims.

45. I have studied the certified translation of the French priority document FR 0012675 that has been provided to me and have found that the text of US 2002/0059412 corresponds exactly to that of the certified translation of the French priority document FR 0012675.
46. US patent application 09/971,946 was filed on October 4, 2001, which is within the required convention period to claim priority from the earlier French application FR 0012675 filed on October 4, 2000.
47. In my opinion, US patent application 09/971,946 in the name of Mr Azpitarte is validly entitled to its priority date of October 4, 2000.
48. A PCT patent application was filed on March 15, 2001 in the name of Siemens AG and designated several inventors of whom the first named was Mr Spira. This application was published under number WO 01/71607 on September 27, 2001.
49. This PCT application designated the USA and resulted in the publication of US Patent Application US 2003/0172002. In accordance with US practice, this application is in the name of the first named inventor, Mr Spira.
50. This application relates to a method of doing business which includes a menu of services. From the menu, services are selected and performed on an outsourced basis to plants such as industrial plants.
51. The published US Patent Application US 2003/0172002, whose teaching forms the basis of the objections by the Examiner against the application in the name of Mr Azpitarte, comprises 25 figures, 27 pages of description and 133 claims.
52. The whole published document comprises 32 pages.
53. The 25 figures comprise detailed and complex block diagrams, process flows and other detailed figures. The 27 pages of description comprise a thorough and detailed explanation of all the elements of the method of doing business that forms the subject of the patent. This full and complete description, taken in combination with the 25 figures, is necessary to allow one of ordinary skill in the art to understand the invention in question.

54. US Provisional Application 60/190,170, of which the priority is claimed in US Patent Application US2003/0172002, was filed on March 17, 2000, in the name of Mr Spira.

55. The application file of this Provisional Application contains two documents:

- The first document comprises a Provisional Application for Patent Cover Sheet to which is attached a nine-page document.
- The second document has no cover sheet but comprises 95 pages of what appears to be a technical brochure.

56. A US Provisional Application is required to have the following documents:

- a cover sheet indicating the names of the inventors, their residence, the title of the invention, the attorney's details, and a correspondence address;
- a specification; and
- drawings where necessary.

57. US Provisional Application No. 60/190,170 fulfils these formal requirements.

58. However, what must be established is whether the technical content of this Provisional Application 60/190,170 is sufficient to allow the later filed US Patent Application US2003/0172002 to be entitled to the earlier date of filing.

59. Of the two documents that make up Provisional Application 60/190,170, the first, nine-page document comprises two pages of extremely brief text relating to a "Method for Providing Maintenance Services". This text comprises six paragraphs.

60. A comparison of the content of these six paragraphs of the Provisional Application and the content of the later filed US Patent Application US 2003/0172002 reveals the following correspondence.

The second paragraph of the Provisional Application which begins "Electronic system plans are employed..." corresponds partially to the wording of Paragraph 0038 of US Patent Application US2003/0172002.

The third paragraph of the Provisional Application which begins "The outsourced maintenance includes..." corresponds partially to the wording of Paragraphs 0040 and 0054 of US Patent Application US2003/0172002.

The fourth paragraph of the Provisional Application which begins "Decisions on maintenance services..." corresponds partially to the wording of Paragraph 0041 of US Patent Application US2003/0172002.

The fifth paragraph of the Provisional Application which begins "Within the content of..." corresponds partially to the wording of Paragraph 0042 of US Patent Application US2003/0172002.

61. Thus, the content of the Provisional Application corresponds partially, but not completely, to paragraphs 0038, 0039, 0040 0054, 0041 and 0042 of US Patent Application US2003/0172002.

62. These paragraphs simply form part of the introduction to the description but do not contain any of the technical content of the later filed US Patent Application Publication US 2003/0172002.

63. Thus, the description of Provisional Application 60/190,170 partially corresponds to six of the paragraphs of the introduction of published US Patent Application US2003/0172002 but does not contain any of the description used in the later filed application.

64. It is important to note that the 27 pages of description of the later filed application comprise 370 paragraphs.

65. While there is at least partial correspondence between part of the text of Provisional Application 60/190,170 and six out of 370 paragraphs of US Patent Application US2003/0172002, there are also discrepancies between the two texts.

66. The first paragraph of Provisional Application 60/190,170 begins "The present invention relates to a modular system of providing technical services." Whereas paragraph 0001 of US

Patent Application US2003/0172002 begins "The present invention relates generally to a management and operation technique ..."

67. Furthermore, the third paragraph of Provisional Application 60/190,170 begins "The present invention provides outsourced maintenance as a part of a business strategy." Whereas paragraph 0039 of US Patent Application US2003/0172002 begins "The present invention provides outsourced technical support as a part of a business strategy."

68. The first document concludes with 28 extremely brief claims, the first of which reads:

"A method for providing technical services, comprising the steps of:
providing a first level of a technical services plan;
providing a second level of a technical services plan; and
providing a third level of a technical services plan."

69. These claims do not correspond to those of the later filed application.

70. Thus, the text of this first document of the Provisional Application does not contain a description that complies with the requirements of 35 U.S.C. 112, first paragraph, namely it would not enable one of ordinary skill in the art to make and use the method of providing maintenance services that is the subject of the later US Patent Application US2003/0172002. Rather, the document is a brief summary of the history of various electronic management systems.

71. This first document goes on to indicate that "The present invention is disclosed in greater detail in the following claims as well as in the attached document comprising 12 brochures, an overview of the brochures, and a print out of slides of a PowerPoint presentation."

72. The second document of the Provisional Application appears to correspond to the description given thereof in the first document in that it appears to comprise brochures, an overview of the brochures, and a print out of slides of a PowerPoint presentation. However, this document is visually of poor quality and, moreover, contains numerous pages in the German language. No English language translation of the pages of Provisional Application 60/190,170 that are in German is on file.

73. A study of the second document shows that of its 95 pages, 21 are in German.
74. As no English translation of the pages has been filed, the pages in question cannot be taken into account when assessing the teachings of Provisional Application 60/190,170.
75. Thus, the teachings of the Provisional Application are limited to what is contained in the remaining 74 pages which are in English.
76. Having examined the documents supplied to me, it is difficult to find any correspondence between the content of published US Patent Application US2003/0172002 and that of the second document of the Provisional Application.
77. None of the 25 figures of published US Patent Application US2003/0172002, which comprise detailed and complex block diagrams, process flows and other detailed figures, appears to be contained in the earlier technical document.
78. Thus, the text of this second document of the Provisional Application also does not comply with the requirements of 35 U.S.C. 112, first paragraph, namely in that it does not contain a description that would enable one of ordinary skill in the art to make and use the method of providing maintenance services that is the subject of the later filed US Patent Application US2003/0172002.
79. Thus, there does not appear to be any correspondence between the technical description of US Patent Application US2003/0172002 and the content of the second document of the Provisional Application.
80. Finally, there does not appear to be any support in any of the documents making up the Provisional Application for the main claims of the later filed Spira application.
81. For example, the first independent claim of US Patent Application US2003/0172002, claim 1, relates to Customer-related technical services for obtaining an optimal financial result of a production plant by continuously applying a series of specific steps.

82. The terms of this claim cannot be found in the documents of Provisional Application 60/190,170.
83. Similarly, later independent claims – for example Claim 68 – are without any support in the documents of Provisional Application 60/190,170.
84. It does not appear from a study of the documents which together make up Provisional Application 60/190,170 that, at the time of filing this application, the inventors were in possession of the invention that is described and claimed in the later filed application 09/971,946.
85. It is my opinion that the content of Provisional Application 60/190,170 is not sufficient to comply with the requirements of 35 U.S.C. 112, first paragraph and enable one of ordinary skill in the art to make and use the invention claimed in US Patent Application US2003/0172002 in the name of Spira only with considerable and undue experimentation.
86. More particularly, the documents that together make up Provisional Application 60/190,170 do not form a written description that provides support for any of the independent claims of the later published application.
87. In view of the preceding discussion and study, I do not believe that US Patent application 09/971,946, published under number US2003/0172002, in the name of Spira is entitled to the filing date of Provisional Application 60/190,170.
88. Given that it is not entitled to its provisional filing date, the effective date of US Patent Application US 2003/0172002 in the name of Spira is its own filing date - March 15, 2001 – which is later than the priority date of US Patent Application 09/971,946 in the name of Mr Azpitarte, namely October 4, 2000.
89. Thus, it is my Opinion that US Patent Application US2003/0172002 in the name of Spira cannot be validly cited as a reference against US Patent Application 09/971,946 in the name of Mr Azpitarte because it is not entitled to its claimed priority date of March 17, 2000 and thus can only benefit from the date of filing of the later published application, namely March 15, 2001.

90. Having established that US Patent Application US2003/0172002 in the name of Spira cannot be validly cited as a reference against US Patent Application 09/971,946 in the name of Mr Azpitarte, it remains to be considered whether the Examiner dealing with US Patent Application 09/971,946 could maintain his objections of lack of novelty and inventive step by basing them on Provisional Application 60/190,170 in place of the later published US Patent Application US2003/0172002.

91. It is to be remembered that US Patent Application 09/971,946 in the name of Mr Azpitarte relates to a system for remotely and automatically controlling, by a facilities management company, maintenance of facilities by a maintenance company with regard to a contract binding the maintenance company to the facilities management company.

92. As has been established in this Declaration, the content of US Provisional Application 60/190,170 is limited to the six paragraphs of the first document which form an extremely brief text relating to a "Method for Providing Maintenance Services" and the 74 pages in English of the second document which comprises brochures, an overview of the brochures, and a print out of slides of a PowerPoint presentation.

93. When I study the content of this Provisional Application I can find no description of a system for remotely and automatically controlling, by a facilities management company, maintenance of facilities by a maintenance company with regard to a contract binding the maintenance company to the facilities management company as claimed in US Patent Application 09/971,946 in the name of Mr Azpitarte, or of a system similar thereto.

94. In my opinion, it is not possible for an Examiner to validly raise the same objections that it would have been obvious to one of ordinary skill in the art to adapt the system disclosed by Spira and so arrive at the invention claimed by Mr Azpitarte in the principal claims of his application, in view of the fact that this earlier document contains almost none of the teachings of the later published document.

95. Thus, in my Opinion, the invention claimed in US Patent Application 09/971,946 in the name of Mr Azpitarte is both novel and comprises an inventive step when compared to the content of Provisional Application 60/190,170 in the name of Spira.

96. Furthermore, I have been asked to give an opinion on the pertinence of the position taken by the Examiner in the Office Action dated March 17, 2008 ("the '2008 office action"), according to which independent claim 13 of the '946 patent application was deemed to be unpatentable over the Spira et al. patent publication no. 2003/0172002.

97. The argumentation of the Examiner with respect to the rejection of claim 13 is set forth on pages 4 – 6 of the 2008 Office Action.

98. It is my opinion that on pages 4 – 6 of the office action, the Examiner fails to find support for the limitations of claim 13 of the '946 patent application in Spira et al.

99. Specifically, the Examiner cites Spira et al. for the claim limitation: "each local monitoring unit comprising: means for measuring operation parameters of the associated piece of facilities for detecting an operational state thereof, control means for allowing a maintenance technician to real time notify the start and the end time of his maintenance or repair task performed on the associated piece of facilities; means for being connected to a transmission network; and means for transmitting through said transmission network said detected operational state of said associated piece of facilities and said maintenance task start and end time."

100. In Spira, at paragraph 0022, it is stated "[t]he modules, which are implemented through software modules and hardware, are installed at a local level in each plant. However, operation and control of the service is provided through regional facilities that are linked to the local facilities by a communication connection, such as through the Internet."

101. In Spira, at paragraph 0354, it is stated "[i]ntegrated sensors are used in power generators to collect measurements continuously during operation so that preventive maintenance actions can be taken when necessary. Continuous monitoring of the conditions on-line or telemonitoring allows the plant to operate at maximum efficiency."

102. Clearly, the Examiner considers the disclosure in Spira about the software modules as being similar to the local monitoring units of the invention claimed in claim 13 of the '946 patent application.

103. Further, the Examiner makes reference to integrated sensors which are used to collect measurements continuously during operation, as elements of such local monitoring units.

104. In my opinion, it does not appear that the Spira disclosure teaches or suggests connecting these sensors to any local monitoring units which comprises in combination means for measuring operation parameters, means for being connected to a transmission network, means for transmitting information through the transmission network and control means for allowing a maintenance technician to real time notify the start and end time of his maintenance task.

105. Thus, it seems that the Examiner asserts that the local monitoring units of the invention would be nothing more than classical sensors, like the sensors effectively disclosed in Spira, which are classically used to collect measurements continuously during operation.

106. In my opinion, the Examiner is reading the claimed local monitoring units very broadly and ignores the fundamental and essential functionality of the monitoring units of the invention allowing a maintenance technician to real time notify the start and end time of his maintenance or repair task, and then allowing a facilities management company to automatically control maintenance of facilities by a maintenance company with regards to the maintenance contract.

107. I disagree with the Examiner that it is an implicit functionality of Spira. Specifically, the Examiner states that there is an implied ability to track the start and end time of the work as well as the repair tasks performed during the maintenance by the technician. It is in my opinion nowhere suggested or taught by Spira that such an ability exists.

108. Even if one can presume that the maintenance services according to Spira are effectively monitored to insure that the maintenance company respect their end of the contract, there is no disclosure in Spira of any means indicating how the maintenance services are concretely monitored and thus how to automatically and real time follow the good execution of the contract binding the maintenance company to the facilities management company.

109. Since there is no disclosure of such means and since there is no recognition in Spira of real time notification, there is nothing which would motivate, teach, or suggest to one of ordinary skill in the art to modify Spira to provide such functionality.

110. Thus, in my opinion, the text of Spira does not contain a description that would enable one of ordinary skill in the art to realize such a local monitoring unit having such a combination of elements.

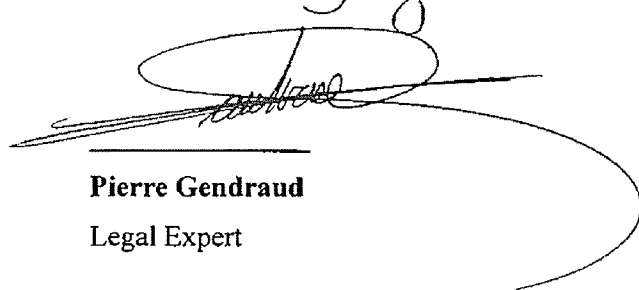
111. I confirm that this Opinion is based on the information contained in the documents listed above that have been communicated to me, and that it takes into account my fundamental obligation to remain at all times objective and impartial as is required by my role as legal Expert.

112. I believe that the information given herein to be true and that my Opinion is both fair and true.

113. I have been informed by Mr Bertrand Warusfel that this Opinion is intended to be filed before the US Patent and Trademark Office and I hereby give my agreement that it shall be so filed.

The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may be jeopardize the validity of the application or any patent issuing thereon.

Signed in Paris, July 17th, 2008



Pierre Gendraud
Legal Expert